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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/638,693

08/15/2000

Geert Maertens

2752-15

2013

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06/03/2004

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Arlington, VA 22201-4717

EXAMINER

MARTINELL, JAMES

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,693

Applicant(s)

MAERTENS ET AL.

Examiner

James Martinell

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-91 is/are pending in the application.
- 4a) Of the above claim(s) 57,58,60-73,75 and 86-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56,59,74 and 76-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 57, 58, 60-73, and 86-91 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 23. None of claims 57, 58, 60-73, 75, or 86-91 embraces an elected invention. Applicants' response filed January 13, 2004 (pages 21-26) contains a discussion of the requirement for restriction. A Decision on Petition in connection with applicants' petition of the requirement for restriction was mailed from the USPTO on May 24, 2004, so applicants' remarks in this regard will not be addressed here.

The response filed January 13, 2004 contains a recitation of claims that is technically in incorrect form in that the withdrawn claims are not labeled as being withdrawn. In order to expedite prosecution of the application, the application is acted on. Applicants are asked to label the claims accurately in their next response.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 56, 59, 74, and 76-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite.

- (a) Claims 56, 59, 74, and 76-85 are vague and indefinite because they embrace more than the elected invention. This rejection is repeated for reasons already of record (e.g., Office action mailed September 11, 2003, page 3, item (b)). Applicants' assertion (response filed January 13, 2004, page 32, item (a)) is not convincing. The metes and bounds of the claims are unclear because the claims include inventions that were not elected.
- (b) The recitation of "genotype-specific amino acid" (claim 56) is vague and indefinite. This rejection is repeated for reasons already of record (e.g., Office action mailed September 11, 2003, page 3, item (b)). Applicants' assertion (response filed January 13, 2004, page 32, item (b)) is not persuasive. Applicants have not pointed how the

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instant application defines the invention. Each application is examined on its own merits.

- (c) Claim 74 is vague and indefinite. This rejection is repeated for reasons already of record (e.g., Office action mailed September 11, 2003, page 3, item (c)). Applicants did not address the point of the rejection with specificity.
- (d) The recitation of "possibly" (claims 82(ii) and 83(ii)) is vague and indefinite. The term "optionally" is suggested as a replacement.

Claims 56, 59, 74, and 76-85 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Simmonds et al (WO 93/10239 (May 27, 1993)). This rejection is repeated for reasons already of record (e.g., Office action mailed September 11, 2003, page 4)). Applicants' argument (response filed January 13, 2004, paragraph bridging pages 26-27) is not persuasive in the absence of indicating with specificity the basis for the instant claims in the priority document.

Claims 56, 59, 74, and 76-85 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chien et al (U.S. Patent No. 6,416,946). This rejection is repeated for reasons already of record (e.g., Office action mailed September 11, 2003, page 4)). Applicants' argument (response filed January 13, 2004, full paragraph on page 27) is not persuasive in the absence of indicating with specificity the basis for the instant claims in the priority document. Applicants' argument (paragraph bridging pages 27-28) is not persuasive in view of the indefiniteness of the claims (see the rejection under 35 USC § 112, second paragraph hereinabove). In addition, the claims recite open language and so are not as limited as applicants argue.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.


James Martinell, Ph.D.
Primary Examiner
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